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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/501,882

08/24/2004

Hironobu Morishita

OHTN:016

9011

6160 7590 06/15/2005

PARKHURST & WENDEL, L.L.P.  
1421 PRINCE STREET  
SUITE 210  
ALEXANDRIA, VA 22314-2805

EXAMINER

BOYKIN, TERRESSA M

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/501,882	<b>Applicant(s)</b> MORISHITA ET AL.	
	<b>Examiner</b> Terressa M. Boykin	<b>Art Unit</b> 1711	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                              |                                                                                         |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7-20-04</u> . | 6) <input type="checkbox"/> Other: _____                                                |

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**Priority**

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

**Claim Rejections - 35 USC § 102**

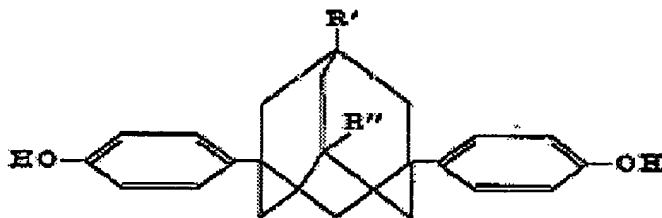
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims are rejected under 35 U.S.C. 102(b) as being anticipated by USP 3594427 see cols. 1 lines 15 and col. 2 line 40, lines 71 through col. 3 line 2., table 1,; or USP 3516969 see cols. 1 and 2, examples 1-3, and claim 1.

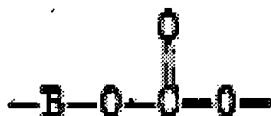
USP 3594427 discloses bisphenols or bis(4-hydroxyphenyl)adamantane, having the structure



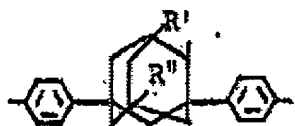
wherein the bisphenol is disclosed as being use to prepare polycarbonates.

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Additionally, USP 35164427 discloses polycarbonates having the repeating units



wherein the B represents



wherein the bisphenol, bis(4-hydroxyphenyl)adamantane, and the like is disclosed as



to be used to prepare the polycarbonate having the repeating units above.

Thus, in view of the above, there appears to be no significant difference between the reference(s) and that which is claimed by applicant(s). Any differences not specifically mentioned appear to be conventional. Consequently, the claimed invention cannot be deemed as novel and accordingly is unpatentable.

### **35 USC 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 3594427 see cols. 1 lines 15 and col. 2 line 40, lines 71 through col. 3 line 2. , table 1,; or USP 3516969 see cols. 1 and 2, examples 1-3, and claim 1 in view of USP 6222001.**

With regard to claim 21-29 the reference discloses a polycarbonate and dihydroxy moiety as claimed by applicants except for the particular optical use.

However, polycarbonates are commonly known to be useful as optical material. Note as just one of the many examples, USP 6222001, see col. 5 line 25 wherein the suitable bisphenols are 2,2-bis(4-hydroxyphenyl)adamantane,. The reference further mentions that the polycarbonate may be used to prepare optical disks. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the bisphenol of either of the references USP 3594427 or USP 3516969 which are both disclosed as used in polycarbonates to be employed in making optical material.

**Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 3594427 see cols. 1 lines 15 and col. 2 line 40, lines 71 through col. 3 line 2. , table 1; or USP 3516969 see cols. 1 and 2, examples 1-3, and claim 1 in view of USP 6291631.**

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As mentioned above, the use of polycarbonates employed as mold material for optical use is widely known. As another example, USP 6291631 discloses that the polycarbonate mold material has particularly acute superior optical qualities. The reference discloses also the use of bis(4-hydroxyphenyl)adamantane as one of the more suitable bisphenols that may be employed. Consequently, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the bisphenol of either of the references USP 3594427 or USP 3516969 which are both disclosed as used in polycarbonates to be employed in making optical material. Consequently, the claimed invention cannot be deemed as unobvious and accordingly is unpatentable.

### **Correspondence**

**Please note that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources. Applicants may be referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.**

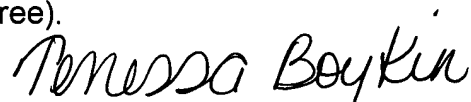
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Terressa Boykin whose telephone number is 571 272-1069. The examiner can normally be reached on Monday through Friday from 6:30am to 3:00pm.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. The general information number for listings of personnel is ( 571-272-1700).

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tmb

  
**Examiner Terressa Boykin**  
**Primary Examiner**  
**Art Unit 1711**